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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,183	07/25/2005	Tateo Uegaki	045616/285784	4362
826 7590 04/23/2009 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER ABDELSALAM, FATHI K	
			ART UNIT 3689	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/517,183

## Applicant(s)

UEGAKI, TATEO

## Examiner

Fathi Abdelsalam

## Art Unit

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 20041207
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is a non-final, first office action on the merits in response to applicant's communication filed on 12/07/2004, wherein claims 1-8 are currently pending.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 12/07/2004 is being considered by the examiner.

***Priority***

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Japan on 6/07/2002.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-6 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 do not positively recite another statutory class to which the method steps are tied and therefore are non-statutory. The recitation of "using a computer to perform repairs" does not suffice. There must be a step in the actual claim, other than the preamble, that explicitly utilizes said computer in a statutory manner.

6. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter) because claim 7 are directed to a "A vehicle provision support program for causing a computer to execute support," which is deemed software *per se*, and therefore considered disembodied functional descriptive material. A computer software application *per se* does not define any structural and functional interrelationships between the computer application and other

claimed elements of a computer which permit the computer application's functionality to be realized.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, obvious under 35 U.S.C. 103(a) over, Segawa et al. (US PG PUB US 20020165791), hereinafter referred to as "Segawa."

10. Regarding **Claims 1, 7, and 8:**

Segawa discloses a vehicle provision support method and program for performing support using a computer to perform repairs on a vehicle and to provide the vehicle to a customer, comprising causing the computer to execute:

a step of, and system means for, presenting a plurality of repair items to the customer ("a repair information notifying part for notifying the repair requester terminal of all the repair information sent from the repairer" [0024]);

a step of, and system means for, accepting selection of repair items of repairs to be performed on the vehicle ("a repair requester finally determines whether or not to accept a repair fee" [0021]);

a step of, and system means for, outputting work items needed for the repairs, based on the repair items accepted ("receiving repair request information at least containing failure information on a product to be repaired and a desired repair fee, transmitted from the repair requester terminal; specifying a repair component based on the failure information" [0025]);

a step of, and system means for, presenting information to the customer, before outputting the work items, the information being used as a judgment criterion for determining whether or not to make the repairs; a step of accepting judgment which is made by the customer after receiving the information used as the judgment criterion; and a step of determining whether or not to output the work items needed for the repairs, based on the judgment accepted ("repairer server further includes an order sending information receiving part for receiving a notice of order sending information from the repair requester terminal, and a selling request notifying part for notifying the component provider that the product or the repair component is purchased at the desired selling price, based on the order sending information. This is because a repair requester finally determines whether or not to accept a repair fee" [0021]). See also

("and an order sending notifying part for notifying the repairer terminal of order sending" [0022]).

Furthermore, the nature of the particular business (vehicle repairs in this instance) has been deemed merely intended usage of the claimed invention and therefore accorded little patentable weight. (Intended use, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone", MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). This rationale implicitly applies to all of the dependent claims hereto.

11. Regarding **Claim 2**:

Segawa discloses a vehicle provision support method according to claim 1, wherein information that contains one of working time needed for the repairs and costs needed for the work is presented in the step of presenting the information used as the judgment criterion. See ("A purchase price of the repair component is determined at this time. Therefore, a repair fee considering a labor cost and like is input at a repair fee input part 71, and the repair fee is sent from a repair information sending part 72 to the repair requester terminal 5, together with repair information such as the kind and number of exchange components and repair complete date and time" [0067]).

12. Regarding **Claim 3**:

Segawa discloses a vehicle provision support method according to claim 1, wherein the plurality of repair items are divided in advance into groups on a clientele basis and selection of the repair items is accepted with the group taken as a unit when accepting the selection of the repair items in the step of accepting the selection of the repair items. See ("customer's unnecessary assets supporting repair of a broken-down apparatus, wherein repair request information at least containing failure information for specifying a product or a component targeted for repair, a desired repair fee, and information on whether or not the use of a second-hand component is accepted is input to go on public on a network, regarding a repair component specified based on the repair request information and a product including the repair component" [Claim 12])-- customer's unnecessary assets used for a repair comprises the plurality of repair items divided in advance into groups on a clientele basis.

13. Regarding **Claim 5**:

Segawa discloses a vehicle provision support method according to claim 1, wherein:

the computer is connectable to a database capable of storing repair items accepted in the past and information on customers selecting the repair items in association with each other ("A component information database and an owner information database are searched based on the specified repair product" [abstract]); and



when the step of presenting the repair items is performed for a new customer, the computer executes:

a step of reading in information on the new customer; a step of extracting information on customers which is similar to the information of the new customer; and a step of presenting repair items to the new customer, the repair items being associated with the extracted customer information ("component information database and an owner information database are searched based on the specified repair product, whereby component providing candidates owning a product including the repair component are selected" [abstract]).

**14. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segawa (US PG PUB US 20020165791).**

**15. Regarding Claim 4:**

Segawa discloses a vehicle provision support method according to claim 1, wherein the repairs are performed and the repaired vehicle is delivered to the customer, the computer further executes:

a step of acquiring a date on which the vehicle is delivered (exchange components and repair complete date and time" [0067]);

But, Segawa does not explicitly disclose a step of computing a fixed date after a predetermined period of time has passed from the vehicle delivery date as a warranty period expiration date; and a step of displaying the computed warranty period expiration date.

However, issuing warranties to customers is well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, when a customer purchases a product--such as a used car--often times dealerships offer a warranty guaranteeing the automobile's quality of operation for a specified time.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Segawa so as to have included a warranty optionality, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Moreover, in KSR, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." In this case the combination of a repair servicing system and process disclosed by Segawa and the well-known warranty functionality would yield a predictable result, specifically viewable warranties offered for repaired vehicles. It would have been obvious to one of ordinary skill in the art to modify Segawa's system/method as such because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in

the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

16. Regarding **Claim 6**:

Segawa discloses a vehicle provision support method according to claim 1, wherein when a part is to be installed in the vehicle during the repairs, the computer further executes:

a step of accepting a judgment as to whether or not the part is to be installed ("repairer server further includes an order sending information receiving part for receiving a notice of order sending information from the repair requester terminal, and a selling request notifying part for notifying the component provider that the product or the repair component is purchased at the desired selling price, based on the order sending information. This is because a repair requester finally determines whether or not to accept a repair fee" [0021]).

a step of computing and presenting costs needed for the part when the part is to be installed as the item in the step of accepting the judgment ("Therefore, when a purchase price of a component exceeds an amount obtained by subtracting a labor cost and the like incurred in repair/exchange from the desired repair fee, the repair/exchange cannot be made under the desired repair fee. In order to avoid this, a purchase reference price presented by the component providing candidate is notified in advance" [0057]).

But, Segawa does not explicitly disclose the part as being a leased item.

However, leasing a product or item to customers is well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, when a customer leases a product—such as a used car—often times dealerships offer a varying leases with varying price tags.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Segawa so as to have included leasing optionality, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Moreover, in KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of a repair servicing system and process disclosed by Segawa and the well-known leasing functionality would yield a predictable result, specifically offering leased parts for repaired vehicles. It would have been obvious to one of ordinary skill in the art to modify Segawa's system/method as such because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in

the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iyonaga, US 20020178219, discloses an apparatus repairing method, system, program and recording medium. Olle, US 20030014142, discloses a method and system for tracking repair of components. Sticha, US 6554183, discloses automated systems and methods for authorization and settlement of fleet maintenance and repair transactions.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fathi Abdelsalam whose telephone number is (571) 270-3517. The examiner can normally be reached on Monday to Thursday 8:00-5:00pm ET.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A./  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
4/22/09